



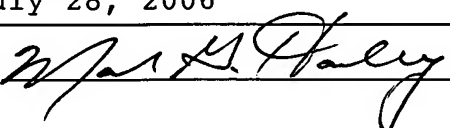

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

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| PRE-APPEAL BRIEF REQUEST FOR REVIEW   |                      | Docket Number (Optional)   |  |
|---|----------------------|--|--|
|   |                      | 20008/G058A  |  |
| I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]<br>on <u>July 28, 2006</u><br>Signature <u></u><br>Typed or printed name <u>Mark G. Hanley</u> | Application Number   | Filed  |  |
|   | 10/616,684           | 07/10/2003   |  |
|   | First Named Inventor |  |  |
|   | Ronald E. Dooley     |  |  |
|   | Art Unit             | Examiner   |  |
|   | 3651                 | Patrick H. Mackey  |  |
| Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.  |                      |  |  |
| This request is being filed with a notice of appeal.  |                      |  |  |
| The review is requested for the reason(s) stated on the attached sheet(s).<br>Note: No more than five (5) pages may be provided.  |                      |  |  |
| I am the  |                      |  |  |
| <input type="checkbox"/> applicant/inventor.  |                      | Signature  |  |
| <input type="checkbox"/> assignee of record of the entire interest.<br>See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.<br>(Form PTO/SB/96)   |                      | Mark G. Hanley   |  |
| <input checked="" type="checkbox"/> attorney or agent of record. 44,736<br>Registration number _____  |                      | (312) 580-1020   |  |
| <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34.<br>Registration number if acting under 37 CFR 1.34 _____   |                      | Telephone number   |  |
|   |                      | <u>July 28, 2006</u><br>Date   |  |
| NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.  |                      |  |  |

☒ \*Total of 1 forms are submitted.

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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Ronald E. Dooley

U.S. Serial No. : 10/616,684

Filed : July 10, 2003

Title : "Multiple Signature Feeder System"

Art Unit : 3651

Examiner : Patrick H. Mackey

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*Chrysa Lisko*  
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**PRE-APPEAL BRIEF**

Mail Stop AF  
 Commissioner for Patents  
 P.O. Box 1450  
 Alexandria, VA 22313-1450

Sir:

In accordance with the Pre-Appeal Brief Conference Pilot Program, the applicant submits this pre-appeal brief accompanying the Pre-Appeal Brief Request for Review. Please consider the following.

**I. Status of the Claims**

Currently, claims 1-34 are pending in this re-issue application. *See Applicant's Response*, March 20, 2006, pp. 2-10. Claims 16-34 stand rejected and form the subject of this pre-appeal brief.

By way of background, this re-issue application was filed on July 10, 2003 with claims 1-30. In the non-final Office action mailed on May 9, 2005, claims 16-34 were rejected under 35 U.S.C. § 103(a) as unpatentable over Osako et al. (5,678,813) in view of one or both of Meier (5,280,895) and Harris, Jr. et al. (5,114,128). The applicant filed a response to the non-final Office action on October 11, 2005, amending claims 26-28, 30, and 31 to clarify the scope of protection sought and traversing the rejections.

The examiner issued a final Office action on December 19, 2005, maintaining the rejections of claims 16-34 under 35 U.S.C. § 103(a) as unpatentable over Osako et al. (5,678,813) in view of one or both of Meier (5,280,895) and Harris, Jr. et al. (5,114,128). The applicant filed a response to the final Office action on March 20, 2006, traversing the rejections.

The examiner issued an advisory action on April 7, 2006, maintaining the previous rejections of claims 16-34. Accordingly, claims 16-34 stand rejected under 35 U.S.C. § 103(a) forming the subject of this pre-appeal brief.

## **II. Issues on Appeal**

The issues on appeal are whether one of ordinary skill in the art would have been motivated at the time of the invention to combine the teachings of Osako et al. and Meier to arrive at the claimed invention.

## **III. Argument**

The applicant respectfully submits that one of ordinary skill in the art at the time of the invention would not have been motivated to combine the references suggested by the examiner.

The applicant respectfully submits that the examiner incorrectly contends that one of ordinary skill in the art would have been motivated at the time of the invention to combine the teachings of Osako et al. and Meier. Specifically, the examiner contends that one of ordinary skill in the art would have modified the Osako et al. system to use a controller disclosed by Meier to select one of a plurality of feeders at a time for the purpose of determining a degree of filling of a packer box and for controlling supply speeds of a feeder system accordingly. *See Final Office Action*, page 3, lines 6-10.

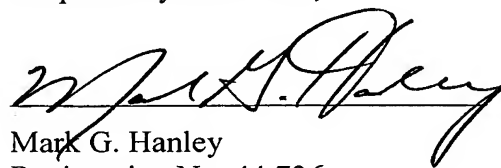
The applicant respectfully submits that modifying Osako et al. as suggested would serve no useful purpose and adding the Meier controller would create unnecessary overhead to the Osako et al. system. *See Applicant's Response*, March 20, 2006, page 11, line 20 through page 12, line 8. Specifically, the Meier system produces printed products having different numbers of signatures and uses a controller to selectively feed individually supplied printed products for selected product groups. *See Id.* In contrast, the Osako et al. system makes a mass of identical books by feeding a signature unconditionally from every feeder in the binding line system and, thus, has no use for the Meier controller because the Osako et al. system does not selectively feed. *See Id.*

The examiner also alleges that one of ordinary skill in the art would have been motivated to combine the teachings of Osako et al. and Meier to make a more efficient and less costly system. *See Final Office Action*, page 5, lines 11-13. The applicant respectfully submits that the examiner has made a mere assertion that is neither capable of instant and unquestionable demonstration nor well known and, thus, does not satisfy the requirements of taking "official notice." *See Applicant's response*, March 20, 2006, page 12, line 19 through page 13, line 10. On the contrary, the applicant respectfully submits that other, more practical solutions exist to address efficiency and cost related to determining a degree of filling of a packer box and for controlling supply speeds of a feeder system. *See Id.*, page 13, line 11 through page 15, line 2. Modifying the Osako et al. system as suggested by the examiner would result in a less efficient (e.g., more expensive) system that would essentially provide the same output without the Meier controller. *See Id.*, page 15, lines 3-10.

The applicant respectfully submits that one of ordinary skill in the art at the time of the invention would not have been motivated to modify Osako et al. in view of Meier because Osako et al. teach a system that operates on a different principle from the Meier system and the suggested modification is not necessary for the Osako et al. system. In addition, such a modification would make the Osako et al. system less efficient because it would incorporate an added cost for an unnecessary, unused function.

In view of the foregoing, the applicant respectfully submits that the examiner has improperly rejected claims 16-34. Accordingly, the applicant respectfully requests withdrawal of the rejections under 35 U.S.C. § 103 and respectfully submits that independent claims 16, 21, 27, and 31 and all claims dependent thereon are in condition for allowance.

Respectfully submitted,



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Dated: **July 28, 2006**



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6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
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